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| 10/023,873      | 12/21/2001  | Takashi Yagita       | 35.C16076           | 4668             |

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EXAMINER

POKRZYWA, JOSEPH R

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2622

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,873

Applicant(s)

YAGITA, TAKASHI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings received on 12/21/01 are acceptable by the examiner.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 33 and 34** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. **Claims 33 and 34** are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. MPEP 2106.IV.B.1(a) (Functional Descriptive Material) states:

“Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized.”

**Claims 33 and 34**, while defining a computer program, does not define a “computer-readable medium” and is thus non-statutory for that reason. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer-readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” - MPEP 2106.IV.B.1(a)

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1-34** are rejected under 35 U.S.C. 102(e) as being anticipated by Smith *et al.* (U.S. Patent Number 6,192,407).

Regarding **claim 1**, Smith discloses an information processing apparatus (server 12 and 315, see Figs. 1-5, and 20) comprising holding means (store 42) for holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), generating means for generating reference information for performing pull print corresponding to

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the print data held in the holding means (column 2, lines 23-36, and column 15, lines 30-42), and issuing means for issuing the reference information for performing pull print corresponding to the print data generated in the generating means to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicatable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 2*, Smith discloses the apparatus discussed above in claim 1, and further teaches that the issuing means is a Web server function processing means in compliance with a predetermined protocol (column 14, line 42-column 15, line 27) and the Web server function processing means issues a print request in compliance with the predetermined protocol to a printing apparatus and transfers the print data held in the holding means to the printing apparatus if a request for obtaining predetermined print data has been returned from the printing apparatus (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 3*, Smith discloses the apparatus discussed above in claim 1, and further teaches that the print data is transmitted via the predetermined communication medium (column 10, line 1-column 11, line 14), the apparatus further comprising receiving means for receiving print data that is transmitted via a predetermined communication medium (column 10, line 1-column 11, line 14), wherein the holding means holds print data received by the receiving means and the generating means generates reference information for performing pull print corresponding to the print data held in the holding means (column 8, line 50-column 9, line 67, and column 15, lines 37-67).

Regarding *claim 4*, Smith discloses the apparatus discussed above in claim 1, and further teaches of notifying means for notifying a second information processing apparatus, which is made communicatable via a predetermined communication medium, of the reference information for performing pull print generated in the generating means (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67), wherein the reference information is for the second information processing apparatus to instruct the printing apparatus to perform pull print via the predetermined communication medium (column 8, line 50-column 9, line 67, and column 15, lines 37-67).

Regarding *claim 5*, Smith discloses the apparatus discussed above in claim 1, and further teaches of recognizing means for recognizing whether or not the printing apparatus that is made communicatable via the predetermined communication medium corresponds to pull print (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67), and determining means for determining whether a print request for push print or a print request for pull print is issued to the printing apparatus according to recognition of the recognizing means (column 3, lines 25-67, column 10, line 52-column 11, line 24, and column 14, lines 55-64).

Regarding *claim 6*, Smith discloses the apparatus discussed above in claim 1, and further teaches that the issuing means issues the reference information for performing pull print corresponding to the print data generated in the generating means to a plurality of printing apparatuses as a print request (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67).

Regarding *claim 7*, Smith discloses the apparatus discussed above in claim 6, and further teaches of transmission control means for transmitting print data to a printing apparatus, which is

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requested to obtain print data first, in response to print requests issued to a plurality of printing apparatuses by the issuing means (column 8, line 50-column 10, line 46), wherein the communication control means controls not to transmit the print data to the printing apparatuses other than the printing apparatus that is requested to obtain the print data first (column 8, line 50-column 9, line 67).

Regarding *claim 8*, Smith discloses the apparatus discussed above in claim 2, and further teaches that the predetermined protocol is an Internet printing protocol (column 9, lines 43-67, and column 14, lines 22-30).

Regarding *claim 9*, Smith discloses the apparatus discussed above in claim 2, and further teaches that a print request in compliance with the predetermined protocol is a Pull request for obtaining the print data and the Pull request includes at least a GET method of an HTTP protocol (column 14, line 42-column 17, line 46) or a get subcommand of an FTP protocol.

Regarding *claim 10*, Smith discloses the apparatus discussed above in claim 1, and further teaches that the reference information for performing pull print is information for specifying a storing place of print data stored in a storage unit and includes at least a URL (column 14, line 42-column 17, line 46).

Regarding *claim 11*, Smith discloses the apparatus discussed above in claim 1, and further teaches of deleting means for deleting the print data held in the holding means according to a response from the print apparatus to which the print data is transferred (column 5, lines 10-30, and column 8, lines 10-55).

Regarding *claim 12*, Smith discloses the apparatus discussed above in claim 11, and further teaches that the deleting means recognizes information for instruction whether or not the

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print data held in the holding means is to be deleted and controls to switch whether or not the print data is to be deleted according to the recognition (column 5, lines 10-30, and column 8, lines 10-55).

Regarding *claim 13*, Smith discloses the apparatus discussed above in claim 2, and further teaches that the Web server function processing means manages the print data held in the holding means and starts server function processing for performing Web server function processing in compliance with a predetermined protocol when a print request is issued from an application to a printing system (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67).

Regarding *claim 14*, Smith discloses the apparatus discussed above in claim 13, and further teaches that the printing system includes a printer driver and a print spooler (column 6, line 40-column 7, line 11, column 12, lines 54-column 13, line 32).

Regarding *claim 15*, Smith discloses a pull print printing system (see Figs. 1-5, 14, 15, and 20) comprising a printing apparatus having a pull print function (printer 178, see Figs. 14 and 15, column 10, line 1-column 11, line 24), generating means for generating reference information for performing pull print corresponding to the print data for which a print request is made by the printing apparatus (column 2, lines 23-36, and column 15, lines 30-42), and instructing means for instructing a printing apparatus, which is made communicatable via a predetermined communication medium, to print the reference information for performing the pull print generated in the generating means (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).



Regarding *claim 16*, Smith discloses an information processing method comprising a step of holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), a step of generating reference information for performing pull print corresponding to the print data held in the holding step (column 2, lines 23-36, and column 15, lines 30-42), and a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicatable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 17*, Smith discloses the method discussed above in claim 16, and further teaches that the issuing step is a Web server function processing step in compliance with a predetermined protocol (column 14, line 42-column 15, line 27) and the Web server function processing step issues a print request in compliance with the predetermined protocol to a printing apparatus and transfers the print data held in the holding step to the printing apparatus if a request for obtaining predetermined print data has been returned from the printing apparatus (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 18*, Smith discloses the method discussed above in claim 16, and further teaches that the print data is transmitted via the predetermined communication medium (column 10, line 1-column 11, line 14), the method further comprising a step of receiving print data that is transmitted via a predetermined communication medium (column 10, line 1-column 11, line 14), wherein the holding step holds print data received in the receiving step and the generating step

generates reference information for performing pull print corresponding to the print data held in the holding step (column 8, line 50-column 9, line 67, and column 15, lines 37-67).

Regarding *claim 19*, Smith discloses the method discussed above in claim 16, and further teaches of a step of notifying a second information processing apparatus, which is made communicatable via a predetermined communication medium, of the reference information for performing pull print generated in the generating step (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67), wherein the reference information is for the second information processing apparatus to instruct the printing apparatus to perform pull print via the predetermined communication medium (column 8, line 50-column 9, line 67, and column 15, lines 37-67).

Regarding *claim 20*, Smith discloses the method discussed above in claim 16, and further teaches of a step of recognizing whether or not the printing apparatus that is made communicatable via the predetermined communication medium corresponds to pull print (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67), and a step of determining whether a print request for push print or a print request for pull print is issued to the printing apparatus according to recognition of the recognizing step (column 3, lines 25-67, column 10, line 52-column 11, line 24, and column 14, lines 55-64).

Regarding *claim 21*, Smith discloses the method discussed above in claim 16, and further teaches that the issuing step issues the reference information for performing pull print corresponding to the print data generated in the generating step to a plurality of printing apparatuses as a print request (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67).

Regarding **claim 22**, Smith discloses the method discussed above in claim 21, and further teaches of a step of transmitting print data to a printing apparatus, which is requested to obtain print data first, in response to print requests issued to a plurality of printing apparatuses in the issuing step (column 8, line 50-column 10, line 46), wherein the communication controlling step controls not to transmit the print data to the printing apparatuses other than the printing apparatus that is requested to obtain the print data first (column 8, line 50-column 9, line 67).

Regarding **claim 23**, Smith discloses the method discussed above in claim 17, and further teaches that the predetermined protocol is an Internet printing protocol (column 9, lines 43-67, and column 14, lines 22-30).

Regarding **claim 24**, Smith discloses the method discussed above in claim 17, and further teaches that a print request in compliance with the predetermined protocol is a Pull request for obtaining the print data and the Pull request includes at least a GET method of an HTTP protocol (column 14, line 42-column 17, line 46) or a get subcommand of an FTP protocol.

Regarding **claim 25**, Smith discloses the method discussed above in claim 16, and further teaches that the reference information for performing pull print is information for specifying a storing place of print data stored in a storage unit and includes at least a URL (column 14, line 42-column 17, line 46).

Regarding **claim 26**, Smith discloses the method discussed above in claim 16, and further teaches of a step of deleting the print data held in the holding step according to a response from the print apparatus to which the print data is transferred (column 5, lines 10-30, and column 8, lines 10-55).

Regarding *claim 27*, Smith discloses the method discussed above in claim 26, and further teaches that the deleting step recognizes information for instruction whether or not the print data held in the holding step is to be deleted and controls to switch whether or not the print data is to be deleted according to the recognition (column 5, lines 10-30, and column 8, lines 10-55).

Regarding *claim 28*, Smith discloses the method discussed above in claim 17, and further teaches that the Web server function processing step manages the print data held in the holding step and starts server function processing for performing Web server function processing in compliance with a predetermined protocol when a print request is issued from an application to a printing system (column 8, line 50-column 9, line 67, and column 14, line 55-column 15, line 67).

Regarding *claim 29*, Smith discloses the method discussed above in claim 28, and further teaches that the printing system includes a printer driver and a print spooler (column 6, line 40-column 7, line 11, column 12, lines 54-column 13, line 32).

Regarding *claim 30*, Smith discloses a processing method comprising a step of generating reference information for performing pull print corresponding to print data for which a print request is made by a printing apparatus (column 2, lines 23-36, and column 15, lines 30-42), a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicatable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29), and a print controlling step for performing pull print control

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processing according to a print request issued in the issuing step (column 15, line 28-column 17, line 29).

Regarding *claim 31*, Smith discloses a computer readable storage medium storing a program (column 10, line 52-column 11, line 14, and column 12, lines 33-65) for executing a step of holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), a step of generating reference information for performing pull print corresponding to the print data held in the holding step (column 2, lines 23-36, and column 15, lines 30-42), and a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 32*, Smith discloses a computer readable storage medium storing a program (column 10, line 52-column 11, line 14, and column 12, lines 33-65) for executing a step of holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), a step of generating reference information for performing pull print corresponding to the print data held in the holding step (column 2, lines 23-36, and column 15, lines 30-42), a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29), and a print controlling step for performing pull print

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control processing according to a print request issued in the issuing step (column 15, line 28-column 17, line 29).

Regarding *claim 33*, Smith discloses a program to be executed by an information processing apparatus (column 10, line 52-column 11, line 14, and column 12, lines 33-65) comprising a step of holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), a step of generating reference information for performing pull print corresponding to the print data held in the holding step (column 2, lines 23-36, and column 15, lines 30-42), and a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicatable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29).

Regarding *claim 34*, Smith discloses a program to be executed by an information processing apparatus (column 10, line 52-column 11, line 14, and column 12, lines 33-65) comprising a step of holding print data for which a print request is made (column 4, line 16-column 5, line 50, and column 15, lines 28-42), a step of generating reference information for performing pull print corresponding to the print data held in the holding step (column 2, lines 23-36, and column 15, lines 30-42), a step of issuing the reference information for performing pull print corresponding to the print data generated in the generating step to a printing apparatus (column 8, line 50-column 9, line 67, and column 15, lines 37-67), which is made communicatable via a predetermined communication medium, as a print request (column 8, line 50-column 9, line 67, and column 15, line 28-column 17, line 29), and a print controlling step for

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performing pull print control processing according to a print request issued in the issuing step (column 15, line 28-column 17, line 29).

#### ***Citation of Pertinent Prior Art***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Tanaka** (U.S. Patent Number 6,519,048) discloses an image forming apparatus; and

**Nagasaka *et al.*** (U.S. Patent Number 6,725,300) discloses system for controlling the transmission and receipt of data.

#### ***Conclusion***

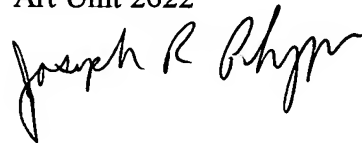
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Joseph R. Pokrzywa  
Primary Examiner  
Art Unit 2622



jrP